UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/769,869	01/25/2001	Clint H. O'Connor	M-9510 US	5280

33438 7590 07/12/2004	**EXAMINER**
HAMILTON & TERRILE, LLP P.O. BOX 203518 AUSTIN, TX 78720	NGUYEN, MINH DIEU T

ART UNIT	PAPER NUMBER
2137	

DATE MAILED: 07/12/2004

5

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-26* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3-7,9-14,16-20 and 22-26* is/are rejected.

7)☒ Claim(s) *2, 8, 15 and 21* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2</u>.

4)☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1.   Claims 1-26 are pending.

Claim Rejections - 35 USC § 102

2.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3.   **Claims 1, 3-7, 9-14, 16-18, 20, 22-26** are rejected under 35 U.S.C. 102(e) as

being anticipated by Biddle et al., US 2002/0107809.

        a)   **As to claims 1, 7, 13, 23 and 25**, Biddle discloses a system and method

for managing licensing of software applications over a network (page 1, paragraph

[0003]) comprising a computer with a processor, memory coupled to the processor, a

first software program operably installed on the computer (Fig. 1, element 30; page 4,

paragraph [0050]); a second software program capable of being operably installed on

the computer and used interoperably with the first software program (page 3, paragraph

[0016]); modifying the second software program to include data defining a specific point

in time after which the second software program cannot be used interoperably with the

first software program (page 12, paragraph [0100]); digitally signing the second software

program including the data defining the specific point in time (page 11, paragraph

[0098]; page 12, paragraph [0102]); determining whether the second software program

has been altered after the digitally signing; verifying that the specific point in time has

not passed and using the second software program interoperably with the first software

program if and only if the determining determines that the second software program has

not been altered after the digitally signing and the verifying verifies that the specific point

in time has not passed (page 12, paragraph [0104].

b)   **As to claims 3, 9, 14, 20, 22, 24 and 26**, Biddle discloses the method

further comprising verifying after the using that the specific point in time has not passed

and blocking interoperable use of the second software program with the first software

program if the specific point in time has passed (page 12, paragraph [0104]).

c)   **As to claims 4, 10 and 16**, Biddle discloses the method wherein the first

software program is an operating system (page 4, paragraph [0050]) and the second

software program is an application software program (page 1, paragraph [0002]).

d)   **As to claims 5, 11 and 17**, Biddle discloses the method wherein the first

software program is an operating system and the second software program is a

peripheral driver (page 4, paragraph [0050]).

e)   **As to claims 6, 12 and 18**, the examiner takes official notice that use of

plug-in program for performing interoperably with the application software program is

quite well known in the software development.

It would have been obvious to one of ordinary skill in the art at the time of the

invention to employ the use of plug-in program for performing interoperably with the

application software program in the system of Biddle so as to provide additional

functionality to the product.

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

5.   Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Biddle et

al., US 2002/0107809.

Biddle discloses a system and method for managing licensing of software

applications over a network (page 1, paragraph [0003]) comprising a computer with a

processor, memory coupled to the processor, an application software program operably

installed on the computer (Fig. 1, element 30; page 4, paragraph [0050]); a plug-in

capable of being operably installed on the computer and used interoperably with the

application software program (page 3, paragraph [0016]); modifying the plug-in to

include a specific set of preconditions limiting use of it interoperably with the application

software program (page 12, paragraph [0100]); digitally signing the plug-in including the

specific set of preconditions (page 11, paragraph [0098]; page 12, paragraph [0102]);

determining whether the plug-in has been altered after the digitally signing; verifying that

the specific set of preconditions limiting use of the plug-in interoperably with the

application software program is met and using the plug-in interoperably with the

application software program if and only if the determining determines that the plug-in

has not been altered after the digitally signing and the verifying verifies that the specific

set of conditions is met (page 12, paragraph [0104].

Biddle discloses the first software program is an operating system and the

second software program is an application software, he does not particularly point out

that one is an application software program and the other is a plug-in to run

interoperably together.

Examiner takes Official Notice that having plug-in module works interoperably

with the application software program is well known in software development.

It would have been obvious to one of ordinary skill in the art at the time of the

invention to allow use of plug-in program for performing interoperably with the

application software program in the system of Biddle so as to provide additional

functionalities to the product.

Allowable Subject Matter

6.   Claims 2, 8, 15 and 21 are objected to as being dependent upon a rejected base

claim, but would be allowable if rewritten in independent form including all of the

limitations of the base claim and any intervening claims.

Conclusion

7.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure

        a)   US Patent 6,212,635 to Reardon discloses network security system

allowing access and modification to a security subsystem after initial installation when a

master token is in place.

        b)   US Patent 6,243,692 to Floyd et al. discloses secure electronic software

packaging using setup external unlocking module.

        c)   US Patent 6,009,401 to Horstmann discloses relicensing of electronically

purchased software.

8.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Minh Dieu Nguyen whose telephone number is 703-305-

9727. The examiner can normally be reached on M-F 6:00-2:30.

        If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Greg Morse can be reached on 703-308-4789. The fax phone number for

the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or

proceeding should be directed to the receptionist whose telephone number is 703-305-

3900.

> Minh Dieu Nguyen
> Examiner
> Art Unit 2137

mdn
6/30/04

GREGORY MORSE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100